



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,266	07/19/2002	Natalie Bryant	FBRIC19.001APC	2913
20995	7590	07/31/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			COBURN, CORBETT B	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3714	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/070,266

Applicant(s)

BRYANT ET AL.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8-22-05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8 & 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The base claims require that the player place a bet in order to be eligible for the additional features. Claims 8 & 17 require that there be additional features for which no bet is placed. It is impossible that the player must place a bet for the additional feature for which no bet is required – logic forbids such an arrangement.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites the limitation "one of the plurality of games as the base game " in lines 2 & 3. There is insufficient antecedent basis for this limitation in the claim – there is no plurality of games described in claim 1.

Art Unit: 3714

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 recites the limitation "the additional feature required " in line 2. There is insufficient antecedent basis for this limitation in the claim – there is no required additional feature in claim 12.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Morro et al. (US Patent Number 5,947,820).

**Claims 1, 2, 12:** Morro teaches a gaming machine that includes a display (the reels) including a plurality of display positions for displaying combinations of symbols.

There is a controller (704) for controlling operation of the machine. The controller includes a processor for processing data and displaying selected data on the display (706). The slot machine includes a selector (708) operable by a player of the machine for enabling the player to select at least one additional feature (i.e., a payline) which can be added to a base game played on the machine such that a base bet configuration provides eligibility for the base game alone and at least one other bet configuration provides eligibility for the base game enhanced with eligibility for the at least one additional feature. If the player makes a base bet on the middle payline (payline 1), he

is eligible to play the base game. Placing bets on paylines 2 and/or 3 provides the base game with the additional feature. The eligibility for the at least one additional feature is available for multiple values of the base bet – the paylines all require the same bet.

**Claim 3:** Different multiples of the base bet purchase different additional features. Each coin the player puts into the slot machine purchases a different payline.

**Claims 4, 13:** The selector comprises a plurality of selectors (coin slots) operable by the player to select the at least one additional feature before making the base bet. Since the bets are interchangeable, any coin can be thought of as the base bet – including the last coin to be bet.

**Claims 5, 14:** The additional at least one other bet staked provides eligibility to a benefit provided by that feature, there being no guarantee that the feature will eventuate merely by having staked the at least one other bet. There is no guarantee that the winning combination will appear on the additional paylines.

**Claim 6, 15:** The additional feature is triggered independently of the base game machine – Each payline is independent of the others.

**Claims 7, 16:** The selector enables a player to select a range of additional features to enable the player to tailor the game to the player's requirements. The player may select between 0 and 4 extra paylines.

**Claims 8, 17:** Morro teaches certain features that are no cost features (i.e., holding letters for the bonus game) & features that require an additional bet (i.e., additional paylines).

**Claims 9, 18:** Morro teaches selection of paylines. Each payline is analogous to a separate game. Thus, by selecting a payline, the player can designate it as a base game.

**Claims 10, 11, 19, 20:** Morro discloses selectors in the form of keypads & touch screens. (Col 3, 43-47)

**Claim 21:** Claim 21 is a conglomeration of the claims rejected above. The eligibility for at least one additional feature (at least one payline) is not dependent on a single value of the base bet. The paylines are purchased independently.

**Claim 22:** The particular value of the base bet comprises a maximum allowed value of the base bet – i.e., one coin.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morro in view of Wood et al. (US Patent Number 5,868,619).

**Claim 23:** Morro teaches the invention substantially as claimed, but fails to teach the feature outcome only being available to be awarded when a feature selecting wager has been staked on the base game and a selector operable by the player to enable the player to stake the feature selecting wager and thereby be eligible to be awarded the feature in the event of a feature outcome occurring in the base game. Wood teaches a game in which the bonus is only available when a feature selecting wager has been

Art Unit: 3714

staked on the base game. (Col 4, 45-53) Obviously, there must be a mechanism for making this bonus wager. Bonus wagers increase the profits of the casino. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified in view of Wood to have the feature outcome only being available to be awarded when a feature selecting wager has been staked on the base game and a selector operable by the player to enable the player to stake the feature selecting wager and thereby be eligible to be awarded the feature in the event of a feature outcome occurring in the base game in order to increase casino profits.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

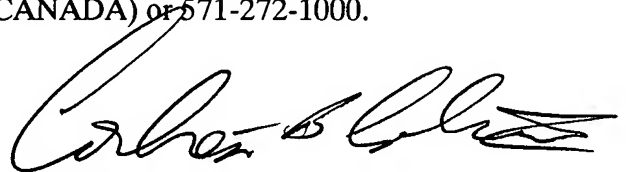
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Corbett B. Coburn', with a stylized flourish at the end.

Corbett B. Coburn  
Primary Examiner  
Art Unit 3714